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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,102	12/05/2003	Uwe Scheim	WAS 0613 PUS / Wa 10265-S	3087
22045	7590	12/07/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,102

Applicant(s)

SCHEIM ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/05 Amendment.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,11 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 5,6,11 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' amendment filed on November 28, 2005 was received.

Claims 1-4, 7-10, 12-15 are deleted. Claims 5-6, 11, 16, 18 and 20 are amended.

Now, Claims 5-6, 11 and 16-20 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 072305) is/are removed.

3. The indicated allowability of Claims 5-6 and 18-19 is withdrawn in view of the new ground of rejection and/or the newly discovered reference(s) to Finger (US 6 254 811). Rejections based on the newly cited reference(s) follow.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 072305).

Claim Objections

5. Claim 11 is objected to because of the following informalities:

In Claim 11 (line 3 from bottom), should "radIcals" be -- radicals --?

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. Claims 5 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP167 (JP 63-083167) in view of Chung (US 4 495 331).

JP167 in view of Chung discloses a process for preparing an organopolysiloxane composition comprising A) a HO end-capped polysiloxane, B) an alpha-aminomethyldialkoxysilane (a chain extender) and C) a silicone compound having at least three hydrolyzable groups (a crosslinker); and utilizing an organic isocyanate as described in paragraph 6 of a prior Office action (Paper No. 0205).

For Claim 5, JP167 teaches that the order of mixing components A)-C) is not critical. (page 4, upper right column) Thus, JP167 obviously discloses the mixing order set forth in the present invention. Furthermore, Chung teaches the use of the organic isocyanate to chemically combine with hydroxy groups such as methanol and water. (col. 3, lines 28-33) Note that the methanol and water are the hydrolysis-condensation by-products. Thus, Chung teaches the incorporation of the organic isocyanate after the mixing of a silanol terminated polysiloxane and an alkoxysilane compound (Example 2), obviously, in order to chemically combine with the hydrolysis-condensation by-products. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to

incorporate the organic isocyanate in the composition of JP167 in view of Chung after the reaction of component A) and component B).

For Claims 16-17, JP167 further teaches, in Application Example 2, the use of a composition comprising 100 parts of hydroxy end-capped polydimethylsiloxane with a viscosity of 4,000 cP and 2 parts of dibutylaminomethylmethyldimethoxysilane. A typical polydimethylsiloxane having 4,000 cP has about 625 repeating dimethylsiloxo units based on the equation described in Freeman (page 27, 3rd paragraph). Note that for a polydiorganosiloxane, the viscosity in terms of cP is similar to that in terms of cs (CSt) because the density of a typical polydiorganosiloxane is close to 1.0. Therefore, 100 parts of this hydroxy end-capped polydimethylsiloxane possesses 0.068 mole of Si-OH groups. Furthermore, 2 parts of dibutylaminomethylmethyldimethoxysilane contains 0.016 mole of Si-OCH₃ groups.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP167 in view of Chung and further as evidenced by Freeman (Silicones, Published for the Plastics Institute, 1962, page 27).

JP167 in view of Chung discloses a process for preparing an organopolysiloxane composition, supra, which is incorporated herein by reference. JP167 further teaches in Application Example 1, where 100 parts of hydroxy end-capped polydimethylsiloxane with a viscosity of 14,000 cP, 2 parts of dibutylaminomethylmethyldimethoxysilane and 0.5 part of methyltrimethoxysilane are used. A typical polydimethylsiloxane having 14,000 cP has about 930 repeating dimethylsiloxy units based on the equation described in Freeman (page 27, 3rd paragraph). Note that for a polydiorganosiloxane, the viscosity in terms of cP is similar to that in terms of cs (CSt) because the density of a polydiorganosiloxane is close to 1.0. Therefore, 100 parts of this hydroxy end-capped polydimethylsiloxane possesses 0.0046 mole of Si-OH groups. Furthermore, 0.5 parts of methyltrimethoxysilane contains 0.011 mole of Si-OCH₃ groups. Therefore, JP167's Si-OH groups in the composition should obviously be completely reacted with the methyltrimethoxysilane.

8. Rejection of Claim 11 under 35 USC 103(a) as being unpatentable over JP167 in view of Chung is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 072305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core

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patentability is discussed below. Note that replacing “organooxy” with -- hydrolyzable -- cannot overcome the rejection.

9. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP167 in view of Chung and Finger (US 6 254 811).

JP167 in view of Chung discloses a process for preparing an organopolysiloxane composition, supra, which is incorporated herein by reference. JP167 in view of Chung is silent on the use of the stabilizer set forth in the instant claims. However, Finger teaches the use of an acid phosphoric ester as a storage stabilizer for a RTV-1 composition comprising an HO-terminated polysiloxane and alkoxysilanes. (col. 3, lines 14-34 and col. 4, lines 18-23) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to add Finger’s storage stabilizer into JP167 in view of Chung’s composition.

Allowable Subject Matter

10. Claim 20 is allowed.

11. The following is an examiner's statement of reasons for allowance:

None of the above references teaches or fairly suggests the use of octylphosphonic acid.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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klp

December 5, 2005


Kuo-Liang Peng
Primary Examiner
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